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Supreme Court of the United States

October Term, 1935

No. 388

A. G. TRIPLETT, R. M. TRIPLETT,
C. M. TRIPLETT, JR., and
THE BALTIMORE GASLIGHT COMPANY,
Defendants-Petitioners,

vs.

PERCIVAL D. LOWELL, FRANCIS W. DUNMORE
and DUBILIER CONDENSER CORPORATION,
Plaintiffs-Respondents.

REPLY BRIEF FOR PETITIONERS.

SAMUEL E. DARBY, JR.,
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REPLY BRIEF FOR PETITIONERS.

I.

We believe that no useful purpose can be served by respondents' attempt to convey the idea that there is any difference, except in scope, between the question presented in the present case and the first question certified to this Court by the Court of Appeals for the Seventh Circuit in the case of *The Mantle Lamp Company of America* v. *Aluminum Products Company* (No. 590). The simple fact is that the first question presented in the *Mantle Lamp* case is whether or not a patentee, after finality of adjudication of invalidity of one or more claims of his patent by a court in one circuit, may maintain a second suit afterward brought

on the same and other claims of the patent, *in the same circuit*, where the patentee has not only failed but has refused to file a disclaimer of the invalidated claims in accordance with the provisions of Section 4922 of the Revised Statute.

The simple but broader question presented in the present case is whether or not the patentee, under such circumstances, can maintain a second suit *anywhere* in the judicial system.

The answer to these questions can and must be found in the provisions of the disclaimer statute—a subject which respondents' brief adroitly avoids and most obviously ignores.

Respondents advance no criticism of the analysis and plain meaning of the language of the statute as given in the main brief for petitioners beginning at page 9. This fact, alone, lends support to the assertion there made and here repeated that the language of the statute is clear, and its meaning capable of but one interpretation, viz.: that when one or more claims of a patent have been finally adjudged to be invalid, the patent in its entirety is thereafter invalid unless the invalidated claims are disclaimed without unreasonable delay. Moreover, this Court has clearly pointed out (in *Ensten* v. *Simon Ascher*, 282 U. S. 455; 75 L. Ed. 453) that it is only through "the benign provisions of the statute", if availed of, that the result of complete invalidity for the patent, by reason of such final adjudication, can be avoided.

Obviously, the filing of a disclaimer of the invalidated claims precludes the thought of maintaining a subsequent suit on the invalidated claims; and failure to disclaim the invalidated claims likewise precludes the thought of maintaining a subsequent suit on other claims of the patent which have thus lost any vestige of validity that they might have had if the disclaimer had been filed.

In their brief, respondents do not attempt to answer these simple propositions, for, obviously, there is no answer thereto which can bear analysis in the light of the clear intent and plain language of the statute.

II.

Respondents argue, under the inapplicable doctrine of *Mast, Foos & Co.* v. *Stover Manufacturing Co.*, 177 U. S. 485, that by virtue of the Act of 1891, which created the Circuit Courts of Appeals, the decision of one Circuit Court of Appeals has only the weight of comity in the Court of Appeals of another circuit, and, in consequence, only that doctrine should apply in a second suit brought for alleged infringement of claims finally adjudged to be invalid in a previous suit in a different circuit.

The complete answer to respondents' contention in this respect is found in the disclaimer statute itself, which again emphasizes the significance of respondents' efforts to completely ignore and avoid discussion of the precise wording and provisions thereof in their brief. Whatever may be the rule of effect on one Circuit Court of Appeals by a decision in another in ordinary cases, the disclaimer statute, by its express provisions, establishes a rule which is as fundamentally controlling as is the section of the statute which created the patent grant. Only in accordance with the permissive provisions of the statute which created it, and to the extent and in the manner permitted therein, may a patent monopoly be enforced. The disclaimer section of that statute expressly limits its permission to maintain a suit on a patent with invalid claims therein to claims which have not theretofore been invalidated, and then, only if the invalidated claims have been disclaimed. No other possible interpretation of the language of the statute has been ad-

vanced by respondents, and it is believed that no other interpretation is possible.

Moreover, it cannot be presumed that it was the intent or purpose, in creating the Circuit Courts of Appeals, to afford a patentee more opportunities to litigate a claim theretofore finally adjudged to be invalid than he had prior to the Act which created those courts. Prior to the Act of 1891 a patentee was confined to a single litigation if invalidity was found. A suit instituted in one District Court could be fought through to finality with final appeal to this Court. If the patent was adjudged invalid by this Court in this first suit no further litigation over the invalid claim was possible. Thus, in one suit, the litigious possibility of the claim was exhausted if invalidity was found, and the litigious possibility of the remainder of the patent was exhausted if the invalidated claim was not promptly disclaimed.

It is confidently asserted, therefore, that there is no rule of law, reason, or logic to support respondents' contention that by the mere creation of the Circuit Courts of Appeals it was intended that thereby a patentee's right to litigate invalid subject matter of his patent is multiplied by the number of Circuit Courts created.

The disclaimer statute was left undisturbed by the Act of 1891. Its meaning and effect are the same today as they were prior to the passage of that Act. Then the patentee was entitled to but one litigation on his patent or any claim thereof if invalidity was the ultimate adjudication. For the same reasons, and under the same unmodified sections of the statute, a patentee today is entitled to no more.

III.

Although respondents reiterate the position taken by them in the Courts below, namely, that the patent should be construed as though no disclaimer had been filed with respect thereto, and although they staunchly adhere to the proposition that even now, at this late date, they are faced with no requirement or necessity for disclaiming the claims previously invalidated by the Court of Appeals for the Third Circuit, respondents seek to excuse their delay of eight months and thirteen days, subsequent to the decision of that Court, in filing the illegal, amendatory disclaimers which were actually filed by them with respect to both of the patents. The excuse advanced is that the patents were involved in interference proceedings, and contests over the title thereto. Surely, interference proceedings and title contests involving the patents constitute no acceptable excuse for failure to comply with statutory requirements. Obviously, any contestants for title have imposed upon them the paramount duty to preserve the life and validity of the subject matter for which the contest is being made. Failure to discharge that duty is inexcusable.

In the final analysis, what is of primary importance is the public right. The public (see *Ensten* v. *Simon Ascher & Co.*, 282 U. S. 455) is entitled to be relieved from "the further evil effects" of the false assertion contained in an undisclaimed invalidated claim of a patent. No private quarrel over title or subject matter can be accepted as an excuse for failure to comply with statutory requirement which is directed to safeguarding the public interest.

Conclusion.

It is submitted that the judgment of the Court below should be reversed, and the decree of the Trial Court dismissing the bill of complaint as to the two patents in suit should be sustained.

Respectfully submitted,

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